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JUL 8 1961
JAMES R. BROWNING, Clerk

Supreme Court of the United States

OCTOBER TERM 1961

No. 164

CHICOPEE MANUFACTURING CORPORATION,
Petitioner,

v.

THE KENDALL COMPANY,
Respondent.

RESPONDENT'S BRIEF IN OPPOSITION TO PETITION FOR CERTIORARI

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Bloomfield Printing Company, Boston, Mass. — Law Printers

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This is simply an ordinary patent case with no "special and important reasons" for granting the writ. There is no conflict of decisions between different Courts of Appeals; no new or doubtful question of law; no conflict between the decision of the Court of Appeals and applicable decisions of this Court or any other court; and no matter of public interest or importance.

We follow Petitioner's designation of record references. Respondent's Appendix pages bear numbers preceded by an "A"; Petitioner's bear page numbers followed by an "a". Page numbers of the Appendix to the Petition are followed by an "s".

PETITIONER'S FIRST REASON

The Court of Appeals admonished the trial court, Williams, J., for adopting as his own "an elaborate opinion*

* The thirty-two page document (A19-52) originally submitted by Petitioner's attorney as an "Opinion" at the Court's request (A809), constitutes, with immaterial changes as to caption and decretal orders

of thirty-two pages"(2s) prepared and submitted at his oral request by Petitioner's counsel, *all without notice to or knowledge of this Respondent.**

The Court viewed such liaison between attorney and court as amounting to "a denial of due process" which would justify a reversal and remand for further proceedings (11s). However, the Court did not act on the view thus expressed, and did not remand for such proceedings. Instead, since the Court found the patent clearly invalid, it reversed with directions to dismiss the Complaint.

Since the Court of Appeals did not decide or dispose of the case on the basis of alleged absence of due process, the Court of Appeals' admonition does not constitute a basis for reversal.

Whether the statement as to due process is or is not dictum, the judgment is not properly subject to attack on this basis. The judgment is subject to reversal only on a finding that the patent is valid. If this Court should take the case under question 2 *(infra)* and decide that the patent is not invalid, then it conceivably might reach the constitutional question of due process. But this fact does not make the constitutional issue, on which the decision and disposition of the Court of Appeals did not rest, an independent ground for certiorari.

Even so, it is the practice of this Court not to decide a constitutional issue when another basis for decision can be

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(A809-813), the so-called Order filed by the Court on June 17, 1960 (A25), and is, as the Court of Appeals said (2s), "an elaborate opinion" including findings of fact and conclusions of law. The lower court's Order of May 12, 1960, in part consists of conclusions of law from a decision in another case, incomplete statements and findings of a general character lifted from Petitioner's brief, without any special findings to support the ultimate facts, and the decretal orders from which Respondent appealed.

* It was only later that the facts were revealed, when Respondent's counsel, whose suspicions were aroused by the character of this thirty-two page opinion, made written inquiry of Petitioner's counsel. The ensuing correspondence between counsel tells the story (A807-820).

found. This Court has asserted that the lower courts should follow the same rule of avoidance (*Alma Motor Co. v. Timken-Detroit Axle Co.*, 329 U.S. 129, 136-137.) Thus, the Court of Appeals was not defying this "traditional policy of our courts," but merely admonishing the lower court on a matter of practice.

By way of completeness and in justice to the Court of Appeals, we will comment briefly on the reasons given by Petitioner for asking for review on the basis of the criticism of the lower court.

First (Pet. p. 25), Petitioner states that this criticism was "based on an erroneous statement of the facts and on unjustified assumptions . . . ". There is no basis for this charge. The Court summarized the essential facts of the procedure of the lower court with accuracy, and indulged in no unwarranted assumptions.

Second, Petitioner charges that "the Court's interest in condemning the practices it assailed, led the Court to disregard the facts of the case as found by Judge Williams . . . " (Pet. p. 25).

As we read this paragraph, Petitioner, without warrant, charges that the Court's prejudice against the lower court so colored its thinking that it was guilty of unjudicial conduct in allegedly disregarding the facts as found by the lower court. The opinion speaks for itself as to its objectivity and judicial character. Moreover, in finding the patent invalid under the *Muncie* doctrine, the Court did not differ from Judge Williams as to any fact. The essential facts, which are documentary, on the basis of which the Court of Appeals ruled that *Muncie* applied, are those referred to in Finding [58] (A40). The issue was one of interpretation of a document—in this case a patent—which is a question of law for the Court. This is hornbook law (Walker on Patents, Deller's Ed., Vol. II, § 245).

Petitioner's Second Reason

Before analyzing Petitioner's second reason, we will summarize the essential background facts.

Summary of Essential Facts

The essential facts as to the art and the patent are reasonably simple. The patent is concerned with a textile fabric which, when washed, will not corrugate in a series of parallel wrinkles, but will remain relatively flat. The gist of the patent is well explained by the Court of Appeals (3a).

If all the warp yarns of a normal cotton textile fabric are of the same direction of twist—either all right-hand ("Z") twist or all left-hand ("S") twist, on washing, the fabric will buckle or corrugate for reasons stated by the Court (3a). If the set of warp yarns are alternately "S" and "Z", buckling or corrugating will not occur and the fabric will lie relatively flat after laundering.

The use of alternate S and Z twists in the warp yarns in a regular pattern (one S, one Z or two S, two Z) had long been an expedient used in the textile art in woven fabrics, other than diaper fabric, for the very purpose of the alleged invention of the patent in suit, i.e., so that after washing the fabric will remain flat (A 713, 721, 723, 685). And Respondent, Kendall, in 1940 had contemplated such use in diapers but concluded that the necessary warping and tying-in required for alternate S and Z was too costly for a cheap fabric such as a diaper.* (D. Ex. 138, see letter of November 26, 1940, and Pl. Ex. BOS 31, 254a, 3-4).

In June 1951, Petitioner's employees, Jamison and Yates,

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* When the new warp yarns are tied up to the warp ends of the woven fabric on the loom, for further weaving, if the S and Z yarns are to be in regular pattern, hand tying-in is necessary and takes many hours. Random tying-in is done by a mechanical device and done very quickly.

filed the application which ripened into patent No. 2,691,391, which became, by reissue, Reissue No. 24,139 in suit.

In this Jamison application the alleged invention was disclosed and claimed as broadly applicable to any "low-count" fabric. By the 1956 Reissue, Petitioner appreciating that the alleged invention, as originally broadly disclosed and claimed as for any fabric, lacked novelty, made substantial changes in both disclosure and claims to limit them to *diaper* fabric and *diapers* of a particular type, i.e. "gauze", not even mentioned in the original application or original patent.

The Jamison application as filed and the original and reissue patents as issued describe and teach that the desired result is to be accomplished "by reversing the twist spun into one out of every two to four yarns in the fabric so that they are of opposed twist to the other warp yarns . . . " (A3, col. 2, lines 21-23), and as the Court of Appeals pointed out (4s), the *preferred** fabric structure is one "with alternate warp yarns having a right-hand twist and the remainder of the warp yarns having a left-hand twist"—that is, S,Z, S,Z, S,Z,—in regular sequence (A3, col. 2, lines 34-36). The original claims (A743) similarly called for a reverse twist "in one out of *every* two to four yarns", in accordance with the only teaching of the specification. The teaching of the specification in this regard has never been changed.

This specific language of the specification and original claims—"one out of *every* two to four" clearly and necessarily means a regular distribution, either: 1S, 1Z; or 1S, 2Z; or 1S, 3Z, so that one out of *every* two to four yarns will contain one of the opposite twist from the others, as the experts on both sides agreed (Backer, A233; Ham-

* Unless otherwise noted, emphasis is ours.

burger, A484-486), and as Petitioner's attorney recognized (*infra*, p. 8).

Petitioner started to manufacture non-corrugating diapers "in 1951 and the early part of 1952" (8s). On instructions of Jamison they were initially made of the preferred structure of the patent application—alternate S and Z 1S, 1Z, 1S, 1Z—in regular pattern. As Respondent had foreseen in 1940 (*supra*, p. 4), Petitioner's mill found that alternating S and Z in any regular pattern is "prohibitively expensive" for a diaper fabric, as everyone now agrees (see for instance Petitioner's own finding [36], A35-36). As the Court of Appeals said, the regular distribution of the patent is "devoid of practical utility" (11s). In March of 1951, Jamison had specified that Petitioner's first mill production be *regular alternate* 1S:1Z warp diapers (D. Ex. NB44, and No. 138 diaper Spec. p. 14D; A821-823). However, Petitioner's mill, after weaving some strict alternate S and Z diaper fabric, balked, and although Jamison "had no hand in it . . . or control over it", the mill ended up, despite Jamison complaining (A503), by producing, as its regular commercial product, diapers in which 50% S and 50% Z warp yarns were distributed *irregularly* at *random* instead of the alternate S and Z which Jamison had specified (A842-843, A500-504).*

Findings Petitioner presented show on their face that the 1951 "further discovery" that "random S and Z could be used" (Finding 41, A36) was *not* the 1950 "invention by Jamison and Yates of the diaper disclosed and claimed in the patents in suit" (Finding 13, A28).

In due course Petitioner's patent department discovered

* Not until early 1952 did Jamison countenance what Petitioner's Southern Mill had accomplished in 1951 by way of random distribution in its diapers then manufactured and sold, as shown by Jamison's new Fabric Specification of April 1, 1952 (A825-827) and testimony (A851-853).

that its commercial diaper employed the random distribution and not the regular "one out of every two to four" specification and claims of its pending Jamison application, language which obviously, and as Petitioner recognized, does not include but is the antithesis of the random distribution of Petitioner's commercial diapers.

Petitioner was in the dilemma that its patent application did not disclose or claim the random distribution of S and Z which its mill had devised and was using. Petitioner knew full well that it could not amend the specification to disclose random distribution. But it hoped that it could accomplish the same effect by filing a new claim couched in such vague and functional terms as would cover random distribution, even though not described or taught in the specification.

This Petitioner did, after an interview with the Patent Office Examiner, by the amendment of October 30, 1953 (A751), when it cancelled all then pending claims in which the limitation to "alternate" or "one out of every two to four" (consistently with the specification) was replaced by new claim language corresponding to that of the issued claim of the original patent and the claims of the reissue:

> "25 to 50 percent of its warp yarns possessing a twist reverse from that of the remainder of the warp yarns and distributed throughout the fabric in a manner sufficiently regular to prevent corrugation . . ." (A752)

It is this vague, functional language which Petitioner contended covers Respondent's irregular random distribution in its diapers charged to infringe.

Therefore, here was a belated broadening of the patented claim to embrace something not previously disclosed or

claimed and, moreover, something that had been in public use for over one year, as Petitioner well knew.

Petitioner had recognized the dilemma created by the fact that its application did not disclose or teach random distribution, for on June 21, 1955, its patent attorney, Harris, had advised the head of its Patent Department as follows (Ex. D, A803):

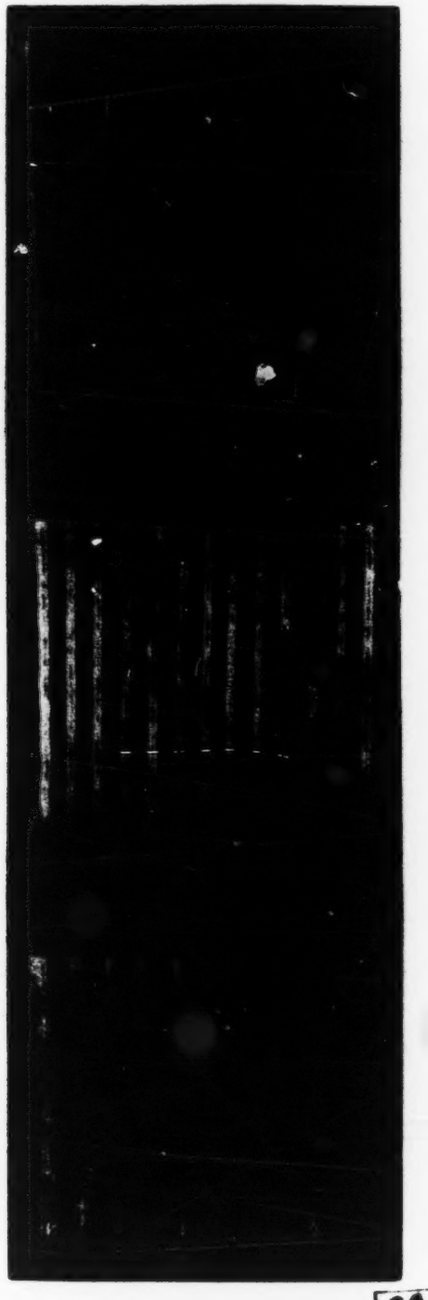
> "D. Breadth of Claim and Public Use.
>
> "I believe you will remember that we discussed that *the diaper fabric sold by Chicopee last year was outside the scope of the specification and claims of this case* [the Jamison & Yates application] *as they were then being prosecuted.* Since public use barred the addition of new matter, we were forced to broaden the claims without adding to the specification. In the claim allowed, the reverse twist yarns are defined as 'distributed throughout the fabric in a manner sufficiently regular to prevent corrugation . . .'"

THE REISSUE

In the reissue, Petitioner by adroit additions to and deletions from the original specification transformed the scope of the alleged invention disclosed as to the kind of fabric, from "low count" fabrics *in general* to "low count" *diaper* fabrics, and even more specifically to a "*gauze*" diaper fabric. This gave basis for contending that the prior art, which taught and disclosed alternate S and Z to avoid corrugation, did not invalidate because such prior art did not teach use of this expedient in a *diaper* fabric or a *gauze* diaper fabric. As the Court of Appeals stated (6s), "These limitations [as to fabric] were inserted to meet the contention that the broader claims [for any fabric] were lacking in novelty."

DEFENDANT'S EXHIBIT NO. 105

Illustrating S and Z warp yarn distributions of the patents in suit: one out of every two; one out of every three; and one out of every four, respectively.



CA 2060 /105

DEFENDANT'S EXHIBIT NO. 142 and NO. 142-1

Illustrating S and Z warp yarn distribution in alleged infringing diaper type SEO 21

As we have seen, the vague, functional language of the issued claim of the original patent was retained in the reissue claims—"having 25 to 50 percent of its warp yarns possessing a twist reverse from that of the remainder of the warp yarns and distributed throughout the fabric in a manner sufficiently regular to prevent corrugation . . .". No change was ever made in the language of the specification in this respect. the sole teaching and disclosure was the regular distribution.

RESPONDENT'S RANDOM DISTRIBUTION

Respondent's diapers charged to infringe are all of irregular random distribution. We reproduce on an insert page two photographs, one of Def's Ex. 105 showing the 1:1, 1:2, and 1:3 alternations of the patents, and their *only* teaching as Petitioner's expert agreed (A484-486), and one of Def's Ex. 142 and 142-1, illustrating the random S and Z warp yarn distribution in one type of alleged infringing diaper, type SEO-21.

Here the S and Z proportions are 25% S to 75% Z wherein the distribution according to the "one out of every two to four" taught by the patent should be alternate one S, three Z. Actually, however, only 15.5% of the Z yarns are even in groups of three, another 16.7% in groups of two and the remaining 67.8% are in groups of 4 to 22 Z's without an S, more than 40% of them being in groups of six or more Z yarns (Pif. Ex. YYY-1, 355a). The haphazard S and Z distribution is the antithesis of the regular alternations taught by the patent in suit. Moreover, the regular distribution taught by the patents is "devoid of practical utility" for diaper fabric, as the Court said (11a), whereas random distribution is practical and commercial.

THE DEFENSES

Respondent contended: (1) the patents are invalid for anticipation and absence of invention; (2) invalidity for vagueness and functionality of claims; (3) if the patents are valid to cover random distribution, such distribution was not the invention of Jamison & Yates, but an invention of the mill; (4) if the claims cover random distribution, they are invalid because not supported by the specification;* (5) no infringement because the claims must be read in the light of, and therefore limited to, the invention disclosed in the specification;** (6) if the claims cover random distribution they are invalid because first presented to the Patent Office by the broadening amendment of October 1953 to cover subject matter not previously disclosed or claimed (random distribution), and which had been in public use for over one year (the Muncie doctrine). There were also contentions of reissue invalidity for new matter, etc.

THE DECISION OF THE COURT OF APPEALS

We have already referred to the Court's criticism of the liaison betwen Petitioner's attorney and Judge Williams (all without notice to Respondent or its counsel), and have shown that its admonition, not acted on, can present no reason for allowance of the petition.

As to the merits, on the basis of which judgment was reversed, the Court considered that Petitioner's attempt to broaden the Jamison application to include new matter not previously disclosed or presented to the Patent Office, and which had become public property through more than a year's public sale, was so clearly within the condemnation

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* "A claim not supported by the specification is a bad claim . . ." *Westinghouse* v. *Metropolitan*, 290 Fed. 661, 664 (2 Cir.).

** *Westinghouse* v. *Boyden*, 170 U.S. 537, 568-9, and see cases in footnote, *infra* p. 15.

of *Muncie* as to dispose of the case and call for reversal, without more.

In reaching this conclusion, the Court went over the essential facts, not in dispute and largely documentary. After reciting the salient facts as to the broadening amendment of October 30, 1953, and the ante-litem conclusion of Petitioner's own attorney that Petitioner's commercial diaper with random distribution "was outside the scope of the specification and claims" of the Jamison application as limited to "alternately" or "one out of every two to four"—wherefore a broadening was necessary to disclose and embrace the random distribution—the Court concluded (10a):

> "There could hardly be a clearer description of an attempt, condemned in *Muncie Gear Co.* v. *Outboard Co.*, supra, to broaden a claim to include matter not described in the specification which had become public property through public sale."

Petitioner tried to make out that "alternately" or "one out of every two to four", if not synonymous, was, in substance, the same as the broader language of the new claim and that the two were in effect equivalent. But the Court of Appeals was not impressed.

THE COURT OF APPEALS CORRECTLY APPLIED THE MUNCIE DOCTRINE

For its second reason, Petitioner (p. 25) contends that the Court's decision misinterprets *Muncie* and is in direct conflict with the *General Talking Pictures* decision.*

The sole issue is simple and clear—the straightforward question of whether the original application discloses and teaches only regular and not random distribution.

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* 304 U.S. 175 (1938) aff'd on rehearing 305 U.S. 124.

In *General Talking Pictures* this Court held that where an inventor first claimed an invention in a divisional or continuation* application more than two years after public use, the claims are valid when the invention of such claims had been shown and described (though not claimed) in the original application as filed, prior to any public use.

The invention of the later filed claims had been presented to the Patent Office by the disclosure of the original application prior to any public use.

The Muncie Case (315 U.S. 759). In this case two of the claims in suit, Nos. 12 and 14, related to a combination in no way disclosed in the specification as filed. Over two years later, the inventor "for the first time made claims" to such combination and amended the application. There had been public use and sale of devices embodying the invention asserted by the new claims more than two years (now one year)** before said invention was first presented to the Patent Office by the filing of the new claims. In holding the claims invalid this Court said (p. 768):

> "The claims in question are invalid if there was public use, or sale, of the device which they are claimed to cover, more than two years *before the first disclosure* thereof to the Patent Office. . . . Section 4886*** of the Revised Statutes would in terms provide for their invalidity had they been offered by application

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* A divisional or continuation application takes the filing date of the original as to all common subject matter. In *General Talking Pictures* it was of no moment that the new claims were filed in a divisional or continuation application rather than in the original application.

** When the amendments in the *Muncie* and *General Talking Pictures* cases were made the statutory public use period was two years. Since 1939 the period has been one year — see 35 U.S.C. 102, quoted at page 3 of the Petition.

*** The pertinent provision of Sec. 4886 is quoted by the Court at p. 766. The current counterpart of Sec. 4886 is 35 U.S.C. 102(b), reproduced at p. 3 of the Petition herein.

rather than by amendment; and whatever may be the efficacy of an amendment as a substitute for an application, it surely can effect no more than the application itself.

"We think the conclusion is inescapable that there was public use, or sale, of devices embodying the asserted invention, more than two years before it was first presented to the Patent Office."*

In the present case, if the new and broadened claim of the amendment of October 1953—filed over a year after public use of a random diaper fabric by Petitioner—had been for an invention *disclosed in the specification*, then the principle of *General Talking Pictures* might apply and there would be no invalidity for prior public use. The invention of the claim then would have been disclosed and presented to the Patent Office in the original specification and prior to public use.

However, since the invention of the new claim "25 to 50 percent", etc., which includes random—was not described and disclosed in the specification but was an invention first presented to the Patent Office in October 1953, more than one year after public use thereof, the case is squarely within the *Muncie* doctrine, as the Court of Appeals found.

The new claim of October 1953, and the reissue claims, describe the invention as one wherein "25 to 50 percent" of the warp yarns have a different twist from the others and "distributed" sufficiently regularly to prevent corruga-

* It can be argued that in *Muncie* two other claims, 11 and 13, were held invalid for late filing after two years public use to cover matter disclosed (but not claimed) in the original specification. If *Muncie* goes that far as to claims 11 and 13, it goes farther than is necessary in this case. The question of late claiming of matter originally disclosed does not arise in the present case and that possible aspect of *Muncie* was not relied upon by Respondent or the Court of Appeals.

tion. The distribution can be regular as described in the specification in which the preferred form is alternately S and Z or of the irregular random distribution which it was the purpose of Petitioner to cover by such broadened claim and which it now claims it does cover. An invention of such scope was certainly not described in the specification but was first presented to the Patent Office in October 1953, more than one year after public use of its subject matter. Therefore, *Muncie* applies.

Petitioner makes an utterly false argument, involving a thorough misrepresentation of the Court of Appeals' decision.

Turning to pages 26 and 27 of the Petition, Petitioner has to recognize that "late disclosure" (after public use) is condemned by *Muncie*. But, Petitioner says (p. 26), since the new claim embraces in its broad coverage not only a fabric with random distribution not disclosed in the application but also the fabric of regular distribution which was disclosed, the new claim is "therefore supported by" the original disclosure and (p. 27) erroneously asserts that the Court of Appeals so agreed.* Therefore, Petitioner argues, since the new claim is "supported" by the disclosure of regular distribution of the specification as filed and never altered in this respect, this case does not come within *Muncie* but within *General Talking Pictures*. The Court, Petitioner states (p. 27), has interpreted *Muncie* to "strike down any claim which first covers a device on sale more than a year before the claim was filed, *no matter what the specification teaches*," in conflict with *General Talking Pictures*.

The Court of Appeals gave no such interpretation to *Muncie* and the falsity and misrepresentation of Petitioner's contention is obvious.

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* This misrepresentation is also made in Petitioner's statement of the background facts, pp. 12, 14.

The issue is clear—was the invention of random distribution now claimed disclosed in the original application?* Obviously such invention was not so disclosed or described, as the Court of Appeals found (10s).

Petitioner's assertion that because the new claims are broad enough to embrace not only a fabric with random distribution (though never disclosed in the specification), but also a fabric of regular distribution (as disclosed in the specification), the specification "supports" the new claims, is not so. A specification "supports" a claim only when it discloses the invention of that claim and thus supplies the basis for such claim. Having erroneously asserted support for random distribution by the original specification, Petitioner's next step—necessary for its argument—is that there was therefore no "late disclosure" of the broad invention of the claim and hence this case is within *General Talking Pictures* and outside *Muncie*. To reach this false conclusion Petitioner erroneously has to state (p. 27) that the Court of Appeals agreed with Judge Williams that the broadened claims "are supported by the original disclosure", whereas the Court held precisely the contrary (10s).

The Court of Appeals (10s) correctly stated the issue, the facts as to disclosure and late filing are not in dispute, and the Court correctly resolved the issue. As the Court held, since the new and broadened claims "include matter [random distribution] not described in the specification which had become public property through public sale", the

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* If these claims are read in the light of the specification, as they must be, then they are limited to the regular distribution which is the sole disclosure and teaching of the patent and are not infringed. *Baker Perkins Co.* v. *Thomas Roulston, Inc.*, 62 F.2d 509, 513, 2 Cir.; *Thompson* v. *Westinghouse El. & Mfg. Co.*, 116 F.2d 422, 425, 2 Cir.; *Carl Braun, Inc.* v. *Kendall-Lamar Corp.*, 116 F.2d 663, 665, 2 Cir.; *Westinghouse* v. *Boyden*, 170 U.S. 537, 568.

Muncie doctrine clearly applies. Conversely, *General Talking Pictures*, where there was disclosure, does not apply.

The other cases cited by Petitioner (pp. 27-28) add nothing. They either follow *General Talking Pictures*, where there was disclosure in the original specification, or *Muncie*, where, as in the present case, there was not the necessary disclosure.

Petitioner's Third Reason

Petitioner asserts that the decision of the Court of Appeals is in direct conflict with the Patent Act of 1952 (35 U.S.C. 112, Pet. pp. 4-5). This reason requires only brief comment.

The statutory provision in question refers only to "means . . . for performing a specified function" which language is not in the claims in this case. These claims are not "means" claims, in whole or in part. And the Court did not purport to decide the case contrary to the statute. Actually, the Court is in agreement with Petitioner that the claims in terms are broad enough to include random distribution. The statement of the Petition (p. 30) is a non sequitur. The issue treated by the Court of Appeals is not what the claims cover but what the specification disclosed, and the Court, exercising its function of interpreting this document, held that it did not disclose random distribution. The Court also found that random is not the equivalent of the regular distribution of the patent teaching,—in particular, holding that the regular distribution of the specification lacks utility, whereas the random distribution is practical and commercial for a diaper fabric. These holdings have nothing to do with the statutory provision relied upon, so far as we can see.

Conclusion

For the foregoing reasons, we submit that the Petition should be denied.

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July 1961

FILED
JUL 20 1961
JAMES R. BROWNING, Clerk

IN THE

Supreme Court of the United States

October Term, 1961
No. 164
4 Cir. No. 8203
W. D. S. C. Civil Action
No. 2060

CHICOPEE MANUFACTURING CORPORATION,
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—v.—

THE KENDALL COMPANY,
Defendant-Appellant-Respondent.

REPLY BRIEF IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FOURTH CIRCUIT

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Kendall says in its brief (e.g. page 2) that it had no notice that Judge Williams would ask one of the attorneys to write an opinion for his consideration. This is incorrect, as shown by the quotation from the trial record in the Petition, pages 8-9, No. 4.

On page 13 of its brief Kendall says:

> "In the present case, if the new and broadened claim of the amendment of October 1953—filed over a year

> after public use of a random diaper fabric by Petitioner —had been for an invention *disclosed in the specification,* then the principle of *General Talking Pictures* might apply and there would be no invalidity for prior public use. The invention of the claim then would have been disclosed and presented to the Patent Office in the original specification and prior to public use."

In this case the Court of Appeals expressly held that the patented claims are supported by the disclosure (Petition, p. 14, No. 22), and that there was no change in the disclosure (Petition, p. 13, No. 18).

Muncie Gear Works, 315 U. S. 759 (1942) requires new matter in the disclosure—such as is now prohibited by 35 U. S. C. 132 (Petition, p. 6).

The sole basis for the decision of the Court of Appeals was *Muncie Gear Works,* which has no application to the facts here. What was done here is expressly permitted by *General Talking Pictures,* 304 U. S. 175 (1938).

Where there has been no change in disclosure, a public use or sale after the application was filed is completely immaterial. A claim may be invalid for other reasons, but not because of such public use.

Kendall contends that the claims are not supported by the disclosure because, it says, they are broad enough to include something more than is disclosed, namely, "random" distribution. This is not non-support. It is only a question of bredth of claim.

Every generic claim, with few exceptions, includes species not specifically disclosed. Every claim held infringed on the basis of equivalents, is so held despite literal non-infringement and usually despite literal non-support.

Patent interpretation is not the prisoner of form or at the mercy of verbalism.

In this case the Court of Appeals held that the claims read on (and are therefore supported by) the disclosure, and read on (and are therefore infringed by) the accused diapers.

The Petition points out (page 15, No. 26) that Jamison and Yates discovered "random" distribution before their application was filed, and attempted to disclose it. If they failed, "random" distribution is nevertheless clearly the full equivalent of "one out of every two to four", and would be so understood by those skilled in the art. It performs the same function in the same way to obtain the same result.

As this Court said in *Graver Tank* v. *Linde Air Products*, 339 U. S. 605, at page 607-8:

> "But courts have also recognized that to permit imitation of a patented invention which does not copy every literal detail would be to convert the protection of the patent grant into a hollow and useless thing. Such a limitation would leave room for—indeed encourage—the unscrupulous copyist to make unimportant and insubstantial changes and substitutions in the patent which, though adding nothing, would be enough to take the copied matter outside the claim, and hence outside the reach of law. One who seeks to pirate an invention, like one who seeks to pirate a copyrighted book or play, may be expected to introduce minor variations to conceal and shelter the piracy. Outright and forthright duplication is a dull and very rare type of infringement. To prohibit no other would place the inventor at the mercy of verbalism and would be subordinating substance to form. It would deprive him of the benefit of his invention and would foster conceal-

ment rather than disclosure of inventions, which is one of the primary purposes of the patent system.

"The doctrine of equivalents evolved in response to this experience. The essence of the doctrine is that one may not practice a fraud on a patent. Originating almost a century ago in the case of Winans v. Denmead (US) 15 How 330, 14 L ed 717, it has been consistently applied by this Court and the lower federal courts, and continues today ready and available for utilization when the proper circumstances for its application arise. 'To temper unsparing logic and prevent an infringer from stealing the benefit of the invention'[1] a patentee may invoke this doctrine to proceed against the producer of a device 'if it performs substantially the same function in substantially the same way to obtain the same result.' Sanitary Refrigerator Co. v. Winters, 280 US 30, 42, 74 L ed 147, 156, 50 S Ct 9. The theory on which it is founded is that 'if two devices do the same work in substantially the same way, and accomplish substantially the same result, they are the same, even though they differ in name, form, or shape.' Union Paper-Bag Machine Co. v. Murphy, 97 US 120, 125, 24 L ed 935, 936. The doctrine operates not only in favor of the patentee of a pioneer or primary invention, but also for the patentee of a secondary invention consisting of a combination of old ingredients which produce new and useful results. Imhaeuser v. Buerk, 101 US 647, 655, 25 L ed 945, although the area of equivalence may vary under the circumstances. See Continental Paper Bag Co. v. Eastern Paper Bag Co. 210 US 405, 414, 415, 52 L ed 1122, 1126, 1127, 28 S Ct 748, and cases cited; Seymour v. Osborne (US) 11

"1 L. Hand in Royal Typewriter Co. v. Remington Rand (CA2d Conn) 168 F2d 691, 692."

Wall 516, 556, 20 L ed 33, 42; Gould v. Rees (US) 15 Wall 187, 192, 21 L ed 39, 40."

In this case the Court of Appeals at page 2s noted with apparent approval that Judge Williams in his opinion of May 12, 1960 (A19—written by himself) had set forth findings of fact that:

> "the inventors had successfully solved a problem with which the scientific research departments of both parties to the case had struggled for fifteen years and that the new invention had had instant and widespread commercial success and had been copied by the defendant."

and the Court of Appeals at page 8s said:

> "Kendall also used the same process in the diaper material which it manufactured and sold after it had obtained and copied the material made by its competitor."

This as clear a case as could be found of "fraud on a patent"—as further shown by Judge Williams' award of treble damages and attorneys' fees.

CONCLUSION

It is accordingly prayed that the Petition be granted.

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July 20, 1961

JUL 29 1961

JAMES R. BROWNING, Clerk

IN THE

Supreme Court of the United States

October Term, 1961

No. 164

4 Cir. No. 8203

W. D. S. C. Civil Action

No. 2060

CHICOPEE MANUFACTURING CORPORATION,

Plaintiff-Appellee-Petitioner,

—v.—

THE KENDALL COMPANY,

Defendant-Appellant-Respondent.

SUPPLEMENTAL REPLY BRIEF IN SUPPORT OF *PETITION FOR WRIT OF CERTIORARI* TO THE UNITED STATES COURT OF APPEALS FOR THE FOURTH CIRCUIT

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SUPPLEMENTAL REPLY BRIEF IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FOURTH CIRCUIT

There has just come to our attention a Petition for Writ of Certiorari to the United States Court of Appeals for the 5th Circuit filed on July 17, 1961, No. 235, October Term, 1961, in the case of *Edward Valves, Inc., et al.* v. *Cameron Iron Works, Inc.*, 289 F.2d 355 (5th Cir., Feb. 7, 1961); on rehearing 289 F.2d 355 (April 18, 1961) (referred to on page 22 of our Petition).

On page 12 of the petition in the *Edward Valves* case a direct conflict is pointed out between the decision of the 5th Circuit Court of Appeals in that case and the decision of the 4th Circuit Court of Appeals in this case.

In the *Edward Valves* case, according to the Petition, the Court of Appeals for the 5th Circuit relied on Findings of Fact written by counsel for the prevailing party and mechanically adopted by the trial judge, even though inconsistent with statements of the trial judge made at the conclusion of the trial.

In the present case the 4th Circuit Court of Appeals disregarded and criticized Findings of Fact written by counsel for the prevailing party, even though completely consistent with a separate opinion written by the trial judge; and not mechanically adopted, but carefully considered, as indicated by the fact that the trial judge put his handwritten initials and the page number on every page of findings.

It is submitted that a review of this case would resolve a broad conflict between circuits on an immediate and recurring problem of importance.

Respectfully submitted,

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